

REMARKS

This Application has been reviewed in light of the Office Action mailed January 14, 2008. At the time of the Office Action, Claims 1-12 and 14-22 were pending in this Application. Claims 1-12 and 14-22 were rejected. Claim 13 was previously cancelled. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §101

Claims 9-12 and 14-22 were rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Although Applicants disagree with the rejections under 35 U.S.C. §101, Applicants have amended the claims as follows in order to advance prosecution:

- Independent Claim 9 is amended to recite “A program product for automatically naming hosts in a distributed data processing system, the program product embodied in tangible computer readable media and comprising ...” (emphasis added).
- Independent Claim 16 is amended to recite “the data processing system comprising: a network interface in communication with a plurality of hosts, a processor in communication with the network interface, tangible data storage in communication with the processor, and computer instructions stored in the tangible data storage, wherein, when the computer instructions are executed by the processor, the computer instructions perform operations comprising ...” (emphasis added)

Amended independent Claims 9 and 16 are directed to statutory subject matter. According to M.P.E.P. § 2106.01:

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or

logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data. (emphasis added).

According to such standards, Claims 9 and 16 clearly recite “functional” rather than “non-functional” descriptive material. Applicant then refers the Examiner back to M.P.E.P. § 2106.01, which explains:

. . . When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)(discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). (emphasis added).

Amended Claim 9 recites a “program product embodied in tangible computer readable media,” and amended Claim 16 recites “tangible data storage in communication with the processor, and computer instructions stored in the tangible data storage, wherein, when the computer instructions are executed by the processor, the computer instructions perform operations comprising ...” Thus, according to the M.P.E.P. guidelines, both Claim 9 and Claim 16 recite “functional descriptive material ... recorded on some computer-readable medium,” and are statutory.

For at least these reasons, Applicants respectfully request the Examiner withdraw the rejections under 35 U.S.C. §101, and allow Claims 9-12 and 14-22.

Rejections under 35 U.S.C. §103

Claims 1-4, 6, 9-11, 16-18, and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication 2002/0161868 issued to Chakkalamattam J. Paul et al. ("*Paul*"), in view of U.S. Patent 5,974,547 issued to Yevgeniy Klimenko ("*Klimenko*").

Claims 5, 7, 8, 12, 14, 15, 19 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Paul*, in view of *Klimenko*, in further view of U.S. Patent No. 5,864,656 issued to Jee-Kyoung Park ("*Park*").

These rejections under 35 U.S.C. §103(a) are identical to those previously presented by the Examiner, e.g., in the Final Office Action mailed October 4, 2006. Applicants maintain their positions regarding these rejections (as stated in the Appeal Brief filed December 13, 2007, the Pre-Appeal Brief Request for Review, and the Response to Final Office Action mailed February 5, 2007), which have not been addressed by the Examiner.

Therefore, Applicants submit that the proposed *Paul-Klimenko* and *Paul-Klimenko-Park* combinations, even if proper (which Applicants do not concede), do not render Applicants claims obvious, and request full allowance of Claims 1-4, 6, 9-11, 16-18, and 22, as well as all claims that depend therefrom.

CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of Claims 1-12 and 13-21.

Applicants believe there are no fees due at this time. However, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2689.

Respectfully submitted,
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